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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
(SAN JOSE DIVISION)

GPNE Corp.,

Plaintiff,

v.

APPLE INC.

Defendant.

Case No. 5:12-cv-02885-LHK

**DEFENDANT APPLE INC.'S
OPPOSITION TO GPNE'S MOTIONS IN
LIMINE NOS. 1-5**

Date: June 26, 2014
Time: 12:00 p.m.
Place: Courtroom 8, 4th Floor
Judge: Hon. Lucy H. Koh

1 **I. GPNE’s Motion *in Limine* No. 1 Should be Denied Because It Seeks to Exclude**
2 **Probative Evidence Critical to Apple’s Damages Case**

3 **A. Response to Derogatory, Disparaging and/or Pejorative References to GPNE**

4 Apple has no intention of introducing derogatory or disparaging terms about anyone,
5 including GPNE, and agrees not to reference the following terms from GPNE’s list: “patent troll,”
6 “pirate,” “bounty hunter,” “privateer,” “bandit,” “paper patent,” “stick up,” “shakedown,” “playing
7 the lawsuit lottery,” “corporate shell game,” and/or “corporate shell.”

8 However, GPNE overreaches by seeking to preclude use of fair and accurate terms such as
9 “patent assertion entity,” “a company that doesn’t make anything,” and “a company that doesn’t
10 sell anything.” GPNE’s status as a non-practicing entity, and whether or not GPNE or its
11 predecessors successfully commercialized the claimed technology, is highly relevant to alleged
12 damages, secondary considerations of non-obviousness (e.g., lack of commercial success), and as
13 overall background as to what the business of GPNE is (or is not).

14 A patentee’s inability to commercialize the claimed technology is probative to *Georgia-*
15 *Pacific* Factors 5, 6, and 10. GPNE’s status as a non-practicing entity demonstrates that it and
16 Apple are not “competitors in the same territory in the same line of business” (GP 5) and that
17 GPNE’s invention is not a “generator of sales of [GPNE’s] non-patented items” (GP 6). Other
18 courts have recognized this and denied motions *in limine* “to exclude references to the lack of
19 products marketed by [company] embodying its [patent]”.¹ Moreover, as GPNE readily admits in

20 ¹ See *NXP B.V. v. Blackberry LTD. et al.*, C.A. No. 6:12-cv-00498-YK [Dkt. No. 419] at 16-17
21 (attached hereto as Exhibit 1) (M.D. Fl. Mar. 25, 2014) (denying attempt to exclude evidence of
22 party’s decision to not develop a product); *HTC Corp. v. Tech. Properties Ltd.*, Case No. 5:08-cv-
23 00882-PSG, 2013 U.S. Dist. LEXIS 129263, *11 (N.D. Cal. Sep. 6, 2013) (permitting HTC to
24 refer to plaintiff as a “non-practicing entity” and a “patent assertion entity,” and neutral language
25 to that effect); *Personalized User Model, L.L.P. v. Google, Inc.*, C.A. No. 09-525-LPS [Dkt. No.
26 606], at 6-8 (attached hereto as Exhibit 2) (D. Del. Feb. 27, 2014) (“Evidence showing that
27 [patentees] were not successful at the times they owned the patents-in-suit is probative of [alleged
28 infringer’s] contention that its own commercial success is in no way due to its alleged practice of
the patented technology”). Indeed, GPNE itself relies upon the alleged commercial success of
others in defending the alleged validity of its patents, and its request to exclude facts that it does
not make or sell a product is contrary to this representation. Compare Ex. 3 (GPNE’s Resp. to
Interrogatory No. 11) (claiming objective indicia of non-obviousness for its patents include
“commercial success” and “adoption and acceptance in the industry”); with *In re GPAC Inc.*, 57
F.3d 1573, 1580 (Fed. Cir. 1995) (addressing patentee’s claim for commercial success of its
patents through licensing of its invention); *Miles Labs., Inc. v. Shandon Inc.*, 997 F.2d 870, 878
(Fed. Cir. 1993) (holding that a lack of commercial success may be probative evidence to rebut

1 its brief, courts have recognized that terms such as “non-practicing entity” are neutral terms and
2 may be utilized if accurate.²

3 **B. Response to GPNE’s Other Prior or Currently Pending Litigations³**

4 GPNE’s licenses are relevant to this case, and GPNE’s licensing practices are equally
5 relevant because they put additional context into how GPNE negotiates licenses, providing the jury
6 with evidence of GPNE’s views about its patents in the market (e.g., potential targets as well as
7 value). Despite the relevance, GPNE seeks exclusion of (1) past litigation settlements that are not
8 contemporaneous with the hypothetical negotiation; and (2) GPNE’s licensing activities relating to
9 alleged infringement by GPRS products. Neither should be excluded.

10 The Court has already rejected GPNE’s request to exclude its past litigation settlements
11 because “GPNE’s licenses are at the very least probative of the royalty to which Apple and GPNE
12 would have agreed in a hypothetical negotiation at the time of first infringement.” Dkt. No. 242, at
13 16-17. Therefore, GPNE’s motion relating to GPNE license agreements should be denied.

14 GPNE’s motion relating to other licensing activities should also be denied because, as
15 GPNE concedes in its Motion, the licensing letters “address alleged infringement of a patent-in-
16 suit, and/or relate to infringement by GPRS products” Dkt. No. 276 at 2. The substance of
17 the *known* licensing activities is outlined in Apple’s Motion to Compel (Dkt. No. 297), particularly
18 the undisputed facts which establish that GPNE has [REDACTED]
19 [REDACTED]

20 claims of commercial success); *Rambus Inc. v. Hynix Semiconductor Inc.*, 254 F.R.D. 597, 605
21 (N.D. Cal. 2008) (holding licensing evidence relevant to claim that invention is not obvious, where
“proof beyond the mere existence of a license” is required).

22 ² See Dkt. No. 276 (citing *HTC Corp. v. Tech. Properties Ltd.*, *Case HTC Corp. v. Tech.*
23 *Properties Ltd.*, Case No. 5:08-cv-00882-PSG, 2013 U.S. Dist. LEXIS 129263, *11 (N.D. Cal.
24 Sep. 6, 2013) (permitting HTC to refer to plaintiff as a “non-practicing entity” and a “patent
assertion entity,” and neutral language to that effect); *Rambus Inc. v. Hynix Semiconductor Inc.*,
25 Nos. C-05-334, C-05-2298, C-06-244, 2008 U.S. Dist. LEXIS 106481, *5 (N.D. Cal. Dec. 29,
2008) (limiting exclusion to the terms “patent troll” and “submarine patent”). The cases GPNE
26 relies upon supports Apple’s position here, that Apple may not use the term “patent troll,” but may
use neutral terms such as “non-practicing entity.” See also *DNT, LLC v. Sprint Spectrum, LP*, No.
27 3:09-cv-21, 2010 WL 582164, *4-5 (E.D. Va. Feb. 12, 2010) (denying motion *in limine* to exclude
28 use of terms “shell company” or “non-practicing entity” because these are neutral terms).

³ Apple agrees not to reference other GPNE litigations, although some reference may be necessary
as GPNE points out in order for Apple to “contextualize finalized settlement/license agreements
referred to in the damages portion of the trial.” Dkt. No. 276, at 1.

1 [REDACTED]
2 [REDACTED]
3 [REDACTED] see also Ex. 6 (Edwin Wong
4 Oct. 24, 2013 Dep. Tr. at 150:6-18) (testifying [REDACTED]
5 [REDACTED]). More
6 recently, and as outlined in Apple's Motion to Compel [Dkt No. 297], publicly available
7 information shows the existence of letters GPNE has withheld from discovery. Further, according
8 to testimony from GPNE's licensing agent Todd Schmidt, these letters [REDACTED]
9 [REDACTED] Ex. 7 (Schmidt Dep. Tr.)
10 at 79:25-80:22; see also *id.* at 59:13-15 ([REDACTED]).

11 The fact that GPNE is actively trying to license its patents—including the patents-in-suit—
12 on the same accused technology is relevant to the overall background of the dispute and at a
13 minimum probative of GPNE's business as compared to Apple's business. See *Georgia-Pacific*
14 *Corp. v. U.S. Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970) (listing as relevant to a
15 reasonable royalty determination "5. The commercial relationship between the licensor and
16 licensee, such as, whether they are competitors in the same territory in the same line of business").
17 Apple should be allowed to show the jury that GPNE has offered to license the same patents-in-
18 suit on the same accused technology, including offers to license [REDACTED]
19 [REDACTED]. Such evidence provides the jury the full
20 story and rebuts GPNE's statements about the value and importance of its patents, for example,
21 where GPNE claims that its patents are essential to LTE systems, when GPNE is telling everyone
22 else [REDACTED].

23 GPNE's primary arguments to exclude the licensing evidence are the following: (1)
24 "[t]hese cases are generally seeking damages far below the amount sought here for many reasons,"
25 and (2) "Apple will attempt to cast unfavorable light on GPNE's recent licensing history and/or
26 licensing strategies . . . where such characterizations have no relevance to other issues in the case."
27 Dkt. No. 276 at 2. Neither argument has merit.
28

1 **First**, the fact that GPNE is [REDACTED]
2 [REDACTED] is relevant to rebut GPNE's damages requests in this case. GPNE argues that its
3 patents are highly important to LTE; [REDACTED]
4 [REDACTED] *See, e.g., SanDisk Corp. v. Round Rock Research LLC*, No., 2014 WL 691565, at *2 (N.D.
5 Cal. Feb. 21, 2014) (holding that documents that "involve IPValue's assessment of SanDisk's
6 business and potential royalty value," such as overviews of Round Rock's patent portfolio and
7 analyses of potential licensing value and licensing targets, is relevant to the reasonable royalty
8 issue).

9 **Second**, the fact that Apple will try and use these [REDACTED]
10 [REDACTED] should not surprise GPNE and is not a basis for exclusion. At bottom, GPNE's
11 objection here is that they do not like evidence that undermines GPNE's damages case, but that is
12 the definition of relevant and probative evidence. GPNE must deal with any unfavorable evidence
13 with its own proofs or cross examination, not by exclusion.

14 **Third**, excluding such evidence would allow GPNE to try its case through an alter-ego
15 personality about its true business. As the Court noted, "GPNE's business model is based entirely
16 on litigation and licensing." Dkt. No. 243, at 17. The jury should be allowed to hear evidence
17 about GPNE's business model and the way it goes about trying to license the patents in suit. Such
18 a broad request to exclude is an improper use of a motion *in limine*. *See Colton Crane Co., LLC v.*
19 *Terex Cranes Wilmington, Inc.*, No. CV 08-8525 PSG (PJWx), 2010 WL 2035800, *1 (C.D. Cal.
20 May 19, 2010) ("In fact, motions *in limine* should rarely seek to exclude broad categories of
21 evidence, as the court is almost always better situated to rule on evidentiary issues in their factual
22 context during trial."); *Carpenter v. Forest Meadows Owners Ass'n*, No. 1:09-cv-01918-JLT,
23 2011 WL 3207778, *1 (E.D. Cal. July 27, 2011). Simply put, GPNE's business practices relating
24 to its sole business of licensing its patents, including the licensing letters, are necessary for the jury
25 to understand the context of this case as well as necessary for the jury in assessing the credibility
26 of GPNE's damages demand against Apple as compared to other parties who have been offered
27 licenses on the same technology.

1 **II. GPNE's Motion *in Limine* No. 2 Should be Denied As Improperly Preventing**
2 **Apple From Challenging the Sufficiency of GPNE's Evidence**

3 GPNE's MIL No. 2 should be denied because it improperly seeks to preclude Apple from
4 challenging the sufficiency of GPNE's evidence of infringement in general and to limit Apple's
5 ability to cross-examine GPNE's expert on infringement issues in particular. At bottom, the
6 motion seeks to prevent Apple from exposing key holes in GPNE's evidence—a subject that is
plainly appropriate for trial and cross-examination of an expert.

7 **A. GPNE Alone Is Responsible for Its Failure to Seek Relevant Evidence from**
8 **Third Parties**

9 The motivation of this motion cannot be a genuine fear that Apple will “lead the jury to
10 believe that GPNE did not satisfy a legal obligation that GPNE never had.” Dkt. 277 at 3. GPNE
11 is instead attempting to shield itself from criticism or consequence of its decision to take not
12 discovery from (1) the entities that GPNE identified in its infringement contentions as making the
13 baseband processors that incorporate the accused GPRS and LTE functionality, or (2) the actual
14 cellular telephone network operators who distribute iPhones and iPads to their subscribers (e.g.,
15 AT&T, T-Mobile). Further still, GPNE seeks to shield its infringement expert, Dr. Dinan, from
16 any criticism owing to his failure to consider evidence from those same third parties.

17 These are all proper subjects of cross-examination. The basis for cross-examination fairly
18 includes Dr. Dinan's selection of materials that he considered and relied upon in forming his
19 opinions, as well as which materials he elected *not to consider at all*. Once the jury has had
20 opportunity to evaluate Dr. Dinan's opinions in complete context, it is within the jury's province to
21 determine how much (if any) weight it will give those opinions. *See Colton Crane Co.*, 2010 WL
22 2035800 at *1 (“In fact, motions *in limine* should rarely seek to exclude broad categories of
23 evidence, as the court is almost always better situated to rule on evidentiary issues in their factual
24 context during trial.”); *Carpenter*, 2011 WL 3207778 at *1 (“Motions *in limine* that seek exclusion
25 of broad and unspecific categories of evidence, however, are generally disfavored.”).

26 **B. The Magistrate Judge Did Not Make Any Evidentiary Rulings**

27 GPNE attempts to convince this Court that Magistrate Judge Grewal already ruled on this
28 issue via an incomplete and out of context citation to a discovery hearing transcript. Dkt. 277 at 2.

GPNE excerpted a substantial discussion between the court and counsel as to the *source*—not the relevance or weight—from which GPNE could obtain one specific item (i.e., baseband log files) via discovery. A more complete presentation of the exchange is as follows:

The Court: Well, ‘cause they have you. You’re subject to the jurisdiction of this court. You’re in this District. You have the information. So why would they go about -- why would they go down to San Diego, file a motion to compel in the southern district, go to all that trouble?

[Apple Counsel]: The answer is I don’t have all the same information that Qualcomm has, your Honor. If one wants to know how Qualcomm source code is developed, exactly what happens in all the various files or routines, I don’t have that information. I cannot substitute an Apple witness as being the same as a Qualcomm engineer. I won’t say that Apple engineers know nothing about Qualcomm base band chips because obviously we would have to integrate them into our phones.

The Court: It’s not the same as designing --

[Apple Counsel]: That’s correct.

The Court: Right.

(Dec. 17, 2013 Hearing Tr. at 54). That is, Magistrate Judge Grewal and Apple counsel were purely addressing a question of discovery procedure concerning third party Qualcomm. Nothing in that record constitutes a ruling on the sufficiency or relevance of any third party evidence. GPNE’s MIL is therefore improper and should be denied.

III. GPNE’s Motion in Limine No. 3 Should Be Denied Because Apple’s Expert Mr. Meyer Has Consistently Disclosed and Testified to the Facts in Question

Mr. Meyer has consistently opined that the number of patent families declared essential to the relevant ETSI standards is substantially higher than 800. GPNE cites nothing to suggest Mr. Meyer has ever varied from this opinion. Both of Mr. Meyer’s reports clearly set forth declared essential patent counts derived from industry research and/or the official ETSI IPR Database. Because Mr. Meyer will not offer testimony that will contradict the patent counts in his reports, GPNE’s motion should be denied.

A. Statement of Relevant Facts

Both Mr. Meyer’s initial rebuttal report and his supplemental report state that more than 800 patent families have been declared essential to the relevant standards in this case, and both include actual numbers in excess of 800. *See, e.g.,* Ex. 8, Expert Rebuttal Report of Paul K. Meyer

1 at ¶ 83; Ex. 9, Expert Supplemental Rebuttal Report of Paul K. Meyer at ¶ 71 (an additional 610
2 patent families for GSM, 1,080 for UMTS, and 2,342 for LTE). Mr. Meyer also explains that the
3 800 number is extremely conservative because it does not include additional patents declared
4 essential to the GPRS, EDGE, CDMA, CDMA 2000 and LTE standards or the thousands of patent
5 families that have been declared essential after Fairfield conducted its studies. *See* Ex. 8, Expert
6 Rebuttal Report of Paul K. Meyer at ¶ 83.⁴ Mr. Meyer’s Supplemental Rebuttal Report reiterates
7 this point. Ex. 9, Expert Supplemental Rebuttal Report of Paul K. Meyer at ¶ 70 (“ . . . my patent
8 family count of 800 is conservative as it does not include the substantial number of patent families
9 declared essential after the Fairfield studies . . . Nor does my 800 patent family count consider
10 unique patent families declared essential to other standards such as GPRS and EDGE or patents
11 that were not declared essential to the standards (such as the patents-in-suit asserted by GPNE).”).
12 Mr. Meyer repeated the same patent counts when deposed. Ex. 10, Transcript of February 21,
13 2014 Deposition of Paul Meyer (“Meyer Tr.”) at 69:9-11 (at least 2400 patents declared essential
14 to GSM and WCDMA since the Fairfield reports); *see also id.* at 179-180 (“ . . . that 800 is going to
15 go to probably 2000 and then drive the value down further.”); *id.* at 192 (testifying that the 800
16 number is conservative and the actual number is much larger).

17 **1. Mr. Meyer’s Opinions Are Not Precluded Under the Doctrine of**
18 **Judicial Estoppel**

19 Judicial estoppel functions to “prohibit[] parties from deliberately changing positions” in
20 litigation. *New Hampshire v. Maine*, 532 U.S. 742, 749-750 (2001). Several factors inform
21 whether to apply the doctrine in a particular case, including (1) whether the current testimony is
22 clearly inconsistent with a prior position; (2) whether the prior position was accepted by the court
23 and, (3) whether the party seeking to assert an inconsistent position would gain an unfair
24 advantage or its opponent would face an unfair disadvantage. *Ah Quin v. Cnty. of Kauai Dep’t of*

25 ⁴ *See also* Ex. 8, Rebuttal Report of Paul K. Meyer at ¶ 83 (over 2,000 patent families declared
26 essential to LTE); *id.* at ¶ 86 (over 1,500 U.S. patent families have been declared essential to GSM
27 and UMTS after the dates of the Fairfield studies); *id.* at ¶ 248 and Table 10 (over 3,000 patents
28 listed in Table 10 above does not include all standards supported by the iPhone and iPad, do not
include patents more recently declared essential and do not include thousands of other patents
related to other features and technologies).

1 *Transp.*, 733 F.3d 267, 270-71 (9th Cir. 2013). None of these factors is satisfied here, and Mr.
2 Meyer has not changed positions.

3 **First**, Mr. Meyer has been consistent in his initial report, his supplemental report, and in
4 the testimony given at both of his depositions that the actual number of declared essential patent
5 families is higher than 800, and that 800 is a highly conservative floor. If he were to present an
6 inconsistent view of these facts, he would be subject to withering cross examination given his
7 repeated statements.

8 **Second**, in allowing Mr. Meyer to testify regarding his Component Royalty Stack
9 Approach, the Court only held that the 800 number was conservative, not that it was concrete or
10 immutable. Indeed, the Court acknowledged the fact that there are many declared essential patents
11 above and beyond the 800 patent family floor.⁵

12 **Third**, GPNE has failed to identify any unfair advantage to Apple or prejudice to GPNE.
13 GPNE's argument that Mr. Meyer will testify to "undisclosed methodologies or facts" is incorrect
14 because the relevant patent counts are already in Mr. Meyer's reports, along with a detailed
15 description of the Component Royalty Stack Approach. Moreover, GPNE cannot possibly be
16 "severely handicapped" in preparing for a trial when GPNE has deposed Mr. Meyer on both
17 reports, his methodology, and the underlying facts used in that methodology.

18 **2. Mr. Meyer's Opinions Are Admissible under Fed. R. Civ. P. 26**

19 Mr. Meyer's reports comply with Rule 26(a)(2)(B). Mr. Meyer's reports contain patent
20 counts for the relevant standards, all of which were obtained using the official ETSI IPR Database
21 or industry reports. GPNE's claim of "litigation ambush" is wholly unfounded. Mr. Meyer has
22 thoroughly explained the operation of the Component Royalty Stack Approach, which this Court
23 already deemed reliable. And as stated above, GPNE has substantial deposition testimony from
24 Mr. Meyer – all of which are consistent on the topic of declared essential patent counts. GPNE has
25 ample time before trial to prepare for the cross examination of Mr. Meyer.

26 _____
27 ⁵ See, e.g., Dkt. 243 at 15 ("...there is some support for finding that Mr. Meyer's royalty figure is
28 reliable because the 800 patent families do not account for all patents that have been and will be
declared essential...").

1 **3. Mr. Meyer’s Opinions Are Admissible Under Federal Rules of Evidence**
2 **402 And 403**

3 Mr. Meyer’s opinions are relevant and not unduly prejudicial and therefore should not be
4 precluded under either Rule 402 or 403. First, the number of declared essential patents is directly
5 relevant to understanding the mindset of the parties at the hypothetical negotiation for the reasons
6 stated in Mr. Meyer’s report. *See* Ex. 8, Expert Rebuttal Report of Paul K. Meyer at ¶¶ 72, 246-
7 248. The context provided by the overall number of declared essential patent families has
8 increased in relevance as a result of Mr. Dansky’s supplemental report, in which he disputes the
9 800 patent family number. Second, GPNE’s argument—that Mr. Meyer’s testimony regarding
10 declared essential patents in excess of the 800 patent family figure will be prejudicial—is
11 misplaced. GPNE claims that such testimony would amount to “permitting an expert to testify
12 about an undisclosed opinion.” Dkt. 279 at 5. Quite the opposite, Mr. Meyer has consistently
13 repeated, throughout both of his reports and his two depositions, that there are thousands of
14 additional declared essential patents. This is not an undisclosed opinion. Rather, it has been a
15 recurring theme of Mr. Meyer’s opinions.

16 GPNE’s argument that testimony from Mr. Meyer regarding the total number of declared
17 essential patents will mislead and confuse the jury is likewise incorrect. Mr. Meyer will not be
18 able to “disavow the analysis” as GPNE suggests. Dkt. 279 at 5. Mr. Meyer will offer testimony
19 regarding the patent counts disclosed and supported in his initial and rebuttal reports and consistent
20 with his deposition testimony on this topic. GPNE will be free to cross-examine Mr. Meyer on any
21 and all aspects of this testimony.

22 **IV. GPNE’s Motion *in Limine* No. 4 Should be Denied Because It Is a Procedurally**
23 **Improper Attempt to Adjudicate Facts**

24 GPNE’s motion should be denied because it improperly seeks the exclusion of evidence
25 that forms the factual basis of one of Apple’s non-infringement arguments. Ignoring that evidence
26 at GPNE’s request requires the Court to become a trier of fact – which is a procedurally improper
27 use of a motion *in limine*.
28

1 **A. GPNE is Asking the Court to Decide an Issue of Fact Relevant to Non-**
2 **Infringement**

3 It is an undisputed fact that the Apple devices could not operate in Dr. Dinan's Agilent test
4 environment without an Agilent SIM card. Taken one step further, both Dr. Wilson and Dr. Dinan
5 agree that the Agilent SIM card determines which "network" the Apple devices utilize. Dr. Wilson
6 states as much in her report:

7 [A]ccording to Dr. Dinan's report, the Apple GPRS devices were not even
8 capable of communicating in that environment until after they were supplied with
9 an Agilent SIM card and activated in that environment. [REDACTED]
10 [REDACTED]
11 [REDACTED]

12 Ex. 11, Expert Report of Dr. Wilson at ¶ 141. GPNE's expert, Dr. Dinan, agrees:

13 Q. Thank you. Were you able to use the Apple products that you tested in the
14 Agilent environment before you installed an Agilent SIM card in them?

15 A. No, I cannot. I have to insert the Agilent SIM card in the device.

16 Q. The Apple products had to be activated for use in that test environment with an
17 Agilent SIM card before they can be used to test or send any GPRS signals?

18 A. That is right.

19 Ex. 12, Dinan Feb. 20, 2014 Dep. Tr. at 61:12-21.

20 This fact is directly relevant to one of Apple's non-infringement arguments: Apple
21 products can only operate in an Agilent test environment if programmed with an Agilent SIM card.
22 In other words, even if one were to accept that the Agilent test environment is a "paging system
23 that operates independently from a telephone network," which it is not, Apple devices are not able
24 to communicate on that "paging system" without an Agilent SIM card. GPNE and Dr. Dinan may
25 disagree with Apple's conclusion, but Apple and Dr. Wilson should be able to offer testimony on
26 this point in support of Apple's non-infringement argument, and Apple should be able to challenge
27 GPNE and Dr. Dinan via cross-examination.

28 Thus, GPNE's premise—that the effect of the SIM card is not relevant to any non-
infringement argument—is incorrect.

1 **A. GPNE’s MIL Is Procedurally Improper**

2 GPNE’s motion is effectively a request for the Court to disregard Apple’s evidence in favor
3 of GPNE’s evidence. But a MIL is an inappropriate means to resolve factual disputes or weigh
4 evidence. *Engman v. City of Ontario*, 2011 WL 2463178, at *9 (C.D. Cal. 2011) (“Defendants’
5 motion appears to be a motion for summary judgment in disguise. Motions *in limine* are an
6 inappropriate means to resolve factual disputes or weigh evidence.”); *Chopourian v. Catholic*
7 *Healthcare West*, 2011 WL 6396500, at *12 (E.D. Cal. 2011) (“This motion presents no clear set
8 of undisputed facts. Indeed, the motion is, as plaintiff argues, a substantive motion disguised as a
9 motion *in limine*, which the court ‘may ... summarily deny.’”); *Louzon v. Ford Motor Co.*, 718
10 F.3d 556, 562 (6th Cir. 2013) (“In light of their limited purpose, motions *in limine* should not be
11 used to resolve factual disputes, which remains the function of a motion for summary judgment,
12 with its accompanying and crucial procedural safeguards.”) (internal citation omitted); *Samsung*
13 *Elecs. Co. Ltd. v. Quanta Computer, Inc.*, No. 00-4524-VRW, 2006 WL 2850028, at *6 (N.D. Cal.
14 Oct. 4, 2006) (denying motion *in limine* asking to resolve “disputed meaning of certain evidence
15 and the disputed credibility of witnesses” as this was “a de facto summary judgment issue” that
16 “[t]he court declines to resolve”). To what extent the inclusion of an Agilent SIM card modifies
17 the operation of an Apple device is a question of fact, and GPNE’s MIL improperly asks the Court
18 to resolve this factual dispute.

19 **B. GPNE’s Reliance on the Court’s MSJ Order Is Misplaced.**

20 GPNE’s motion improperly suggests that the Court’s April 9, 2014 Order resolved a factual
21 issue in favor of GPNE. In that order on Apple’s motion for summary judgment, the Court
22 identified a *dispute* of fact as to the effect of the Agilent SIM card on the operation of the Apple
23 products, when viewing the record evidence in the light most favorable to the non-moving party
24 (GPNE). Dkt. No. 239, at 5-6 (“Summary judgment is appropriate if, viewing the evidence and
25 drawing all reasonable inferences *in the light most favorable to the nonmoving party*, there are no
26 genuine disputed issues of material fact, and the movant is entitled to judgment as a matter of
27 law.”) (emphasis added). The Court’s ruling in its April 9, 2014 Order was not a factual finding as
28

1 to the effect of the SIM card on the Apple products in the Agilent environment, and the Court
2 should not allow GPNE to use motions *in limine* for factual determinations.

3 **V. GPNE’S Motion *in Limine* No. 5 Should Be Denied Because It Is Based on Misleading**
4 **Grounds and, in Any Event, Seeks Disproportionate Relief**

5 GPNE bases this motion on an incorrect premise: that Apple will “improperly suggest[] to
6 the jury that GPNE acted in bad faith in obtaining the patents.” Dkt. No. 281 at 1. Apple has not
7 done so—GPNE’s alleged support for this concern is based on a handful of out-of-context quotes
8 taken from early motion practice over issues that have been long settled. Nor, as GPNE suggests,
9 will Apple argue laches. However, Apple should be free to refer to the chronology of the patents-
10 in-suit, to place the alleged inventions into correct historical context, as required for Apple to
11 present its case. To the extent that GPNE’s motion seeks to prevent such contextual evidence and
12 arguments, the motion should be denied.

13 **A. GPNE’s Alleged Evidence in Support of Its Motion Is Misleading and**
14 **Irrelevant**

15 GPNE provides four examples that it alleges to support its fear that Apple will “improperly
16 suggest[] to the jury that GPNE acted in bad faith in obtaining the patents”:

- 17 • “GPNE has continuously prosecuted this patent family for nearly two
18 decades.” *See, e.g.*, Dkt. No. 53, p. 9, l. 15;
- 19 • “. . . the accused GPRS standard has existed for more than ten years, and some
20 of the accused products have been on the market since the patents issued.” *See*
21 Dkt. No. 57, p. 3, ll. 14-15;
- 22 • “All three Patents-in-Suit claim priority to, and share a common specification
23 with, a June 1994 application that concerns a stylized, 1994-era paging
24 network . . .” . . . [the] “extended prosecution history . . . spans sixteen years
and includes many continuation applications.” *See* Dkt. No. 72, p. 1, ll. 7-8 &
15-16;
- “GPNE then spent the following nine years filing still further continuation
applications (including the applications for the Patents-in-Suit) using
hindsight to draft claims that, it contends, cover the wireless protocols that the
market actually adopted without GPNE’s participation.” *See id.*, p. 1, l. 21 – p.
2, l. 2.

25 Dkt. No. 281 at 1.

26 GPNE’s first citation—in which Apple and other defendants made the observation that
27 “GPNE has continuously prosecuted this patent family for nearly two decades”—is from a motion
28 concerning GPNE’s attempt to circumvent the prosecution bar in this case’s Protective Order and

1 have its litigation counsel participate in the reexamination proceedings. *See generally* Dkt. Nos.
2 50, 53, 55. In the actual full quote, the defendants stated that such participation was unnecessary:
3 “GPNE has continuously prosecuted this patent family for nearly two decades, ***and its prosecution***
4 ***counsel presumably understands the technical subject matter and the pertinent prior art.***” Dkt.
5 No. 53 at 9:15-16 (emphasis added).

6 GPNE’s second excerpt—in which Apple and other defendants observed that “the accused
7 GPRS standard has existed for more than ten years, and some of the accused products have been
8 on the market since the patents issued”—is from defendants’ motion to stay this case pending the
9 results of the reexaminations. *See generally* Dkt. Nos. 57 and 60. The actual full passage stated:

10 The first of the asserted patents issued in June 2009, the accused GPRS standard has
11 existed for more than ten years, and some of the accused products have been on the
12 market since the patents issued. GPNE did not file suit until July 2011, and when it
13 did, it improperly joined unrelated defendants. ***Because GPNE was previously***
content to postpone its “day in court” for years, the Court should not risk further
waste of judicial and party resources over the next two years in construing claims
that will likely be canceled or substantially changed.

14 Dkt. No. 57 at 3:13-19 (emphasis added).

15 Nor do GPNE’s third and fourth excerpts have anything to do with laches or “bad faith” in
16 obtaining the patents. Both excerpts come from Apple’s and the other defendants’ *Markman* brief
17 and concern GPNE’s quest to frame its asserted claims as pertaining to generic “data
18 communication devices” rather than the pagers described in the specification. *See generally* Dkt.
19 No. 72 at 1-2. GPNE lost that argument, and the Court properly construed the claimed “node” to
20 be a type of pager, not a generic “data communication device.” Any attempt by GPNE to use this
21 motion *in limine* to position itself to reargue a claim construction at trial is improper.

22 **A. Apple Should Be Free to Present Dates Relevant to Its Claims and Defenses,**
23 **Just As GPNE Will Be**

24 Although “bad faith” prosecution and laches will not be trial issues, the timeline of GPNE’s
25 patents is relevant to Apple’s claims and defenses. For example:

26 First, the effective filing date of the patents-in-suit (June 24, 1994) is relevant to both
27 Apple’s non-infringement and invalidity defenses, which require the evaluation of the knowledge
28 of a person of ordinary skill in the art at the time of the invention. *See, e.g., Ariad Pharm., Inc. v.*

1 *Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010 (for a patent’s written description, “the test
2 for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those
3 skilled in the art that the inventor had possession of the claimed subject matter as of the filing
4 date”); *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 870 (Fed. Cir. 1993) (obviousness
5 is measured by the knowledge of one of ordinary skill in the art at the time of filing); *Phillips*, 415
6 F. 3d at 1313 (“[T]he ordinary and customary meaning of a claim term is the meaning that the term
7 would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of
8 the effective filing date of the patent application.”); *see also* Ex. 13, Expert Report of Esmael H.
9 Dinan at 2 (“For the terms that were not construed, I read and understood them as one of ordinary
10 skill in the art would have at the time of the GPNE patents were filed.”).

11 Second, the patents-in-suit were still pending when Apple first began to sell products
12 GPNE contends are infringing. (Ex. 14, Expert Report of Michael J. Dansky at 25-26.) The
13 hypothetical negotiation date is thus defined by the issue dates of the patents-in-suit and is directly
14 relevant to damages. *See, e.g., Wang*, 993 F.2d at 870 (holding that patent issue date was proper
15 hypothetical negotiation date when accused products were already being sold on that date).

16 Third, GPNE itself has placed on its preliminary exhibit list documents that evaluate other,
17 earlier GPNE patents against the accused GPRS protocol. *See, e.g.,* Ex. 15, GPNE Preliminary
18 Exhibit 302 (GPNE_MPM_006283-GPNE_MPM_006301), listed as [REDACTED]
19 [REDACTED]
20 [REDACTED] Ex. 16, GPNE Preliminary Exhibit 309 (GPNE_MPM_003757-
21 GPNE_MPM_003766), listed as [REDACTED] To the
22 extent GPNE is allowed to elicit testimony about such documents at all, Apple must be able to
23 clearly present to the jury the timeline of GPNE’s patent family in relation to that of the accused
24 standards. To do otherwise would be grossly prejudicial to Apple and almost certainly would
25 confuse the jury.

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For all these reasons, GPNE’s Motion *in Limine* No. 5 should be denied.

Dated: June 5, 2014

By: /s/ Christopher O. Green
Christopher O. Green